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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:)	
)	
Watts, Jr., et al.)	Examiner: Simone, Catherine A.
)	
Serial No.: 10/783,076)	Art Unit: 1772
)	
Filed: February 20, 2004)	Confirmation No.: 6275
)	
For: SURFACE COVERING HAVING)	Customer No.: 00112
DIFFERENTIAL GLOSS-IN-)	
REGISTER)	Docket No.: 0122A

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Reply Brief is submitted pursuant to 37 CFR 1.193(a) in response to the Examiner's Answer mailed September 25, 2007 in the above-identified application. Since November 25, 2007, was a Sunday, this Reply Brief, being mailed with a Certificate of Mailing on November 26, 2007, is timely filed.

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STATUS OF CLAIMS

Claims 34 to 49 are pending in the application. Claims 34 to 49 stand rejected.

Claims 1 to 33 are canceled. The rejection of all the pending claims is appealed.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 34, 38, 39, 41 to 43, 47 and 48 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bomboire U.S. Patent No. 4,089,724 ("Bomboire").

Claims 45, 46 and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bomboire in view of Schmidle et al. U.S. Patent No. 4,273,819 ("Schmidle").

ARGUMENT

In the Advisory Action mailed from the U. S. Patent and Trademark Office on September 25, 2007 ("Examiner's Answer"), the Primary Examiner has maintained the rejection of claims 34 to 49.

Attorney for Applicants continues to argue separately the patentability of claims 34, 41 and 49. The remaining claims stand or fall with claim 34 from which they directly or indirectly depend.

This Reply Brief will respond to the Examiner's arguments set forth in the Examiner's Answer, which as mailed September 25, 2007 ("Examiner's Answer").

Section 102(b) Rejection of Claims 34 and 41 as being anticipated by Bomboire

Below the middle of page 3 of the Examiner's Answer, the Examiner states that "Regarding claim 34, Bomboire discloses a coated freestanding film." Attorney for Appellants disagrees. A "freestanding film" is defined by Webster's Dictionary online to be a thin covering or coating ("film") standing alone or on its own foundation free of support or attachment ("freestanding"). When the discontinuous layer 33 of Bomboire is applied to the continuous wear layer 41 (film), the wear layer is already attached to the support or base sheet 1. Also, the print layer 31 is first applied to the support or base sheet 1 before the wear layer 41 is attached to the print layer.

Therefore, the floor or wall covering of Bomboire, which has all of the elements required by claim 34, is not a freestanding film. It includes the support or base sheet 1 and falls outside the definition of freestanding film.

If one takes the position that the entire Bomboire structure is a freestanding film, as does the Examiner in construing “consisting essentially of” as equivalent to “comprising”, the Bomboire structure again falls outside the definition of freestanding, film because the Bomboire structure is not thin. Therefore, claim 34 is allowable over Bomboire for this reason as well as the reasons argued in the Appeal Brief.

Regarding claim 41, at the top of page 4 of the Examiner's Answer, the Examiner cites column 5, line 46, of Bomboire to support the position that Bomboire teaches a film comprising a plurality of layers. However, the cited passage of Bomboire (col. 5, lines 44 to 46) states “the support 1 ... may be comprised of one or more layers.” Bomboire does not teach or suggest that the wear layer or film 41 contains more than one layer, as required by claim 41. Therefore, claim 41 is allowable over Bomboire for this reason as well as the reasons argued in the Appeal Brief.

Even if one takes the position that “consisting essentially of” as equivalent to “comprising”, claim 34 from which claim 41 depends requires the film to be interposed between the print layer and the discontinuous layer. The support 1 of Bomboire is not interposed between the print layer and the discontinuous layer. Therefore, claim 41 is allowable over Bomboire for this reason as well.

Section 103(a) Rejection of Claim 49 as being unpatentable over Bomboire in view of Schmidle

The Examiner applies Bomboire against claim 49 in the same manner as against claim 34. The Examiner relies on Schmidle for a teaching of mechanical embossing. Claim 49 has all of the limitations as claim 34 except the limitation of a print layer.

Bomboire does not teach a freestanding film. When the discontinuous layer 33 of Bomboire is applied to the continuous wear layer 41 (film), the wear layer 41 is already attached to the support or base sheet 1. Therefore, the floor or wall covering of Bomboire, which has all of the elements required by claim 49, is not a freestanding film. It includes the support or base sheet 1 and falls outside the definition of freestanding film.

If one takes the position that the entire Bomboire structure is a freestanding film, as does the Examiner in construing "consisting essentially of" as equivalent to "comprising", the Bomboire structure again falls outside the definition of freestanding, because the Bomboire structure is not thin. Therefore, claim 49 is allowable over Bomboire for these reasons as well as the reasons argued in the Appeal Brief.

Response to Examiner's Comments Regarding Rejection of claims 34 and 41 as anticipated by Bomboire and claim 49 as obvious over Bomboire in view of Schmidle

At the bottom of page 8 of the Examiner's Answer, the Examiner states that "no evidenced has been provided to show that the presence of such a support or base 1 taught in Bomboire would materially affect the basic and novel characteristics of the claimed invention." However, in repeating the Appellants' position that paragraph 7 of the specification teaches the "need for a surface covering which has a differential gloss effect printed onto a film which is in-register with a printed or mechanically embossed pattern or design thereon" which is a basic and novel characteristic of the claimed invention, the Examiner glosses over the phrase "onto a film" and ignores Appellants' reference to paragraph 4 of the specification.

As set forth in paragraph 4 of the specification, by forming a freestanding film with a print design on one surface and an in-register differential gloss pattern on the other side, the floor or wall covering manufacturer can avoid the cost of “multiple coat cure stations consisting of a coater and ultraviolet (UV) medium pressure-mercury vapor lamps” required by the “filmless product” of the prior art, including Bomboire. As stated in paragraph 4 of the specification, the “[c]apital investment requirements in radiation cure equipment utilized to apply such coatings onto a decorative substrate can be significant.”

This is evidence that the presence of the support or base 1 taught by Bomboire would materially affect the basic and novel characteristics of the claimed invention. Therefore, claims 34, 41 and 49, and the claims dependent thereon are allowable over Bomboire for this reason as well as the reasons argued in the Appeal Brief.

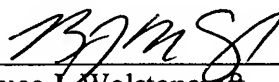
Near the top of page 9 of the Examiner's Answer, the Examiner states “the surface covering in Bomboire appears to have the same basic and novel characteristics as that of the claimed invention. So it is unclear to the Examiner how the support or base 1 of Bomboire would materially change the basic and novel characteristics of Applicant's claimed invention.” Again, it is the lack of the support or base of the claimed invention that allows the floor or wall covering manufacturer to make a floor or wall without the capital investment of multiple coating and curing stations. Therefore, the transitional phrase “consisting essentially of” cannot be construed as equivalent to “comprising” and claims 34, 41 and 49, and the claims dependent on claim 34 are allowable over Bomboire for this reason as well as the reasons argued in the Appeal Brief.

Near the middle of page 9, the Examiner refers to col. 3, lines 4 to 6, in addition to col. 5, lines 44 to 46, for support for the position that the surface covering of Bomboire can include a plurality of film layers. As previously discussed the column 5 cite is directed to the support or base 1 and not the wear layer or film 41. In like manner, the column 3 cite states "it is possible to directly print the decoration on a stable support which may comprise one or more layers constituting the final support or backing for the product." Therefore, once again, Bomboire teaches a multi-layered support and not a multi-layer wear layer or film that is interposed between a print layer and a discontinuous layer. Therefore, claim 41 is allowable over Bomboire for this reason as well as the reasons argued in the Appeal Brief.

Accordingly, all of the pending claims should be found allowable. Reversal of the rejections is respectfully requested.

Respectfully submitted,

11/26/07
Date




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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22213-1450 on November 26, 2007.



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